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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,642	04/04/2006	Mikko Nevalainen	BKS.002.WUS	8247
7590 Hollingsworth & Funk 8009 34Th Avenue South Suite 125 Minneapolis, MN 55425			EXAMINER HUSSAIN, IMAD	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/561,642

Applicant(s)

NEVALAINEN, MIKKO

Examiner

IMAD HUSSAIN

Art Unit

4117

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☒ Claim(s) 5, 9-11, 17 and 21-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB088)
- Paper No(s)/Mail Date 20 December 2005.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-23 are pending in application 10/561,642.

Claim Objections

2. Claims 9-11 and 21-23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 9-11 and 21-23 are directed towards computer program products and carrier waves whereas the claims they depend from are directed to methods.
3. Claims 5 and 17 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10, 11, 22 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In this case, computer-related inventions whether descriptive or functionally descriptive material are non-statutory categories when claimed as descriptive material per se (see *Warmerdam*, 33 F.3d at 1360 USPQ2d at 1759), falling under the "process"

category (i.e. inventions at that consist of a series of steps or acts to be performed).

See 35 U.S.C. 100(b) ("The term process means, art, or method, and includes a new of a known process, machine, manufacture, composition of matter or material").

Functional descriptive material: "data structures" representing descriptive material per se or computer program representing computer listing per se (i.e. software per se) when embodied in a computer-readable media are still not statutory because they are not capable of causing functional change in the computer. However, a claimed computer-readable storage medium encoded with a data structure, computer listing or computer program, having defined structural and functional interrelationships between the data structure, computer listing or computer program and the computer software and hardware component, which permit the data structure's, listing or program's functionality to be realized, is statutory (see MPEP 2106).

Claims 10 and 22 are directed to computer programs. Computer software per se is unpatentable, as explained above.

Claims 11 and 23 are directed to carrier waves. Carrier waves do not fall under the four categories of statutory subject matter and are hence unpatentable.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-11 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by John Varland (WO 01/86997 A1, hereinafter Varland).

Regarding claim 1, Varland discloses a *method for determining and notifying users having substantially matching preference profiles* [Varland: Page 3 (2) Lines 14-22], *for accessing a multiple access online application* [Varland: Page 3 (2) Lines 23-26] *destined for a plurality of mobile terminal devices each being connected to a wireless communication network* [Varland: Page 2 (1) Line 30] *and being related to said users, said method comprising:*

- receiving a preference profile including identification data and preference data related to at least one of said users, from a mobile terminal related to said at least one user* [Varland: Page 3 (2) Lines 1-2 and 9-14];

- saving said received identification data and said received preference data in a user database, said user database containing preference data of at least one other user* [Varland: Page 7 (6) Lines 19-23];

- comparing said received preference data with said preference data of said at least one other user for determining users of substantially matching preference data* [Varland: Page 3 (2) Lines 14-19];

- determining a plurality of users having said substantially matching preference data* [Varland: Page 3 (2) Lines 14-19]; *and*

- sending a notification to each of said mobile terminals related to said determined users* [Varland: Page 3 (2) Lines 14-22].

Regarding claim 2, Varland discloses *granting to each of said notified users an access to said multiple access online application* [Varland: Claim 4 and Page 4 (3) Lines 10-21].

Regarding claim 3, Varland discloses *a method for notifying a user having a preference profile substantially matching with at least one other user* [Varland: Page 3 (2) Lines 14-22], *for accessing a multiple access online application* [Varland: Page 3 (2) Lines 23-26] *destined for a plurality of mobile terminal devices each being connected to a wireless communication network* [Varland: Page 2 (1) Line 30] *and being related to users, comprising:*

-sending a preference profile including identification data and preference data of said user to a server connected to said wireless communication network, via said network [Varland: Page 3 (2) Lines 1-4 and 9-14]; *and*

-receiving a notification from said server, said notification comprising an offer to get access to said multiple access online application according to said preference data, wherein said notification comprises data to enable an access of said user to said multiple access online application [Varland: Claim 4 and Page 4 (3) Lines 10-21].

Regarding claim 4, the claim comprises the same limitations as claims 3 and 2. The same rationale for rejection is applicable.

Regarding claim 5, the claim comprises the same limitations as claims 1 and 3. The same rationale for rejection is applicable.

Regarding claim 6, Varland discloses that *said wireless communication network is a cellular telephone network* [Varland: Page 5 (4) Lines 35-37].

Regarding claim 7, Varland discloses that *said notification is a short message or a multimedia message* [Varland: Page 11 (10) Lines 32-34].

Regarding claim 8, Varland discloses that *said multiple access online application is a wireless communication network game* [Varland: Page 15 (14) Lines 15-22].

Regarding claims 9-11, the claims comprise substantially the same limitations as claim 1. The same rationale for rejection is applicable.

Regarding claim 18, the claim comprises the same limitations as claims 3 and 6. The same rationale for rejection is applicable.

Regarding claim 19, the claim comprises the same limitations as claims 3 and 7. The same rationale for rejection is applicable.

Regarding claim 20, the claim comprises substantially the same limitations as claims 3 and 8. The same rationale for rejection is applicable.

Regarding claims 21, 22 and 23, the claims comprise substantially the same limitations as claim 3. The same rationale for rejection is applicable.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varland in view of William F. Zanchi (US 5630159 A, hereinafter Zanchi).

Regarding claim 12, Varland discloses a network terminal device for notifying a user having a preference profile substantially matching with at least one other user [Varland: Page 3 (2) Lines 14-22], *for accessing a multiple access online application* [Varland: Page 3 (2) Lines 23-26] *destined for a plurality of mobile terminal devices each being connected to a wireless communication network* [Varland: Page 2 (1) Line 30] *and being related to users, wherein said terminal device is configured to send a preference profile including identification data and preference data of said user via said interface and via said network to a server and configured to receive a notification from said server*

[Varland: Page 3 (2) Lines 1-4 and 9-14], *said notification comprising an offer to get access to said multiple access online application according to said preference data, wherein said notification comprises data to enable an access of said user to said multiple access online application* [Varland: Claim 4 and Page 4 (3) Lines 10-21].

Varland does not explicitly disclose that the terminal comprises:

- an interface to a wireless communication network for exchanging data with at least one server connected to said wireless communication network;*
- a database to store identification data and preference data of a user of said terminal device; and*
- a processor connected to said interface and said database.*

However, Zanchi teaches such an interface [Zanchi: Claim 6 ("port couples... by a wireless connection")], such a database [Zanchi: Claim 1 ("session preference memory... storing preferences")], and such a processor [Zanchi: Claim 1 ("controller")].

Varland and Zanchi are analogous art in the same field of endeavor, as both cover matching of user profiles in a networked environment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the matching system of Varland with the memory card and hardware scheme of Zanchi for implementation of a cellular telephone and server because in doing so the matching system of Varland would allow for users to transfer profiles seamlessly from one device to another [Zanchi: Column 2 Lines 37-38 and 46-48].

Regarding claim 13, Varland-Zancho teaches that *said processor is further configured to access a multiple access online application via a wireless communication network, in accordance with said received data to enable said access of said multiple access online application* [Varland: Claim 4 and Page 4 (3) Lines 10-21].

Regarding claim 14, Varland-Zancho discloses *an interface for connecting an exchangeable memory device* [Zancho: Figure 1 and Column 2 Lines 49-51].

9. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Varland in view of Taniguchi et al. (US 2002/0013869 A1, hereinafter Taniguchi).

Regarding claim 15, Varland teaches a *network server for determining and notifying users having substantially matching preference profiles* [Varland: Page 3 (2) Lines 14-22], *for accessing a multiple access online application* [Varland: Page 3 (2) Lines 23-26] *destined for a plurality of mobile terminal devices each being connected to a wireless communication network* [Varland: Page 2 (1) Line 30], *and being related to said users, wherein said network server comprises:*

- a database to store data received from said terminal devices* [Varland: Figure 1 ("Client DB" and "Position DB")];

- means for comparing said received preference data with preference data of at least one other user for determining users of substantially matching preference data* [Varland: Figure 1 ("Match DB")]; *and*

-means for sending a notification to each of said mobile terminals related to said determined users [Varland: Claim 1 ("notification signal")]

-wherein said interface is adapted to receive said preference profile including identification data and preference data from at least one mobile terminal [Varland: Page 3 (2) Lines 1-2 and 9-14], *and said database is adapted to store said preference profile* [Varland: Figure 1 ("Client DB" and "Position DB")].

Varland does not explicitly disclose:

-an interface to a wireless communication network for exchanging data with terminal devices connected to said wireless communication;

-and a processor being connected to said interface and said database to process data;

However, Taniguchi discloses such an interface [Taniguchi: Paragraph 0121] and such a processor [Taniguchi: Paragraph 0121].

Varland and Taniguchi are analogous art in the same field of endeavor, as both cover client-server communication on a wireless network. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the matching system of Varland with the server components of Taniguchi for implementation of a cellular telephone and server because in doing so the matching system of Varland would allow for a physical implementation of the system.

Comment [IHI1]: Not sure about the motivation. Having a processor and interface on the server are just short of inherent, so I used this reference as an example implementation of a server.

Regarding claim 16, the claim comprises the same limitations as claims 15 and 7 as discussed above. The same rationale for rejection is applicable.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Varland in view of Zanchi as applied to claim 12 above and in view of Taniguchi as applied to claim 15 above.

Regarding claim 17, the claim comprises the same limitations as claims 12 and 15 as discussed above. The same rationale for rejection is applicable.

Conclusion

11. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to IMAD HUSSAIN whose telephone number is (571)270-3628. The examiner can normally be reached on Monday through Thursday from 0730 to 1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beatriz Prieto can be reached on 571-272-3902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IH/
Imad Hussain
Examiner

/Prieto, Beatriz/
Supervisory Patent Examiner, Art Unit 4117